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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,019	09/23/2005	Sumie Suda	278231US0PCT	3841

22850	7590	11/02/2007
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.		
1940 DUKE STREET		
ALEXANDRIA, VA 22314		

EXAMINER	
FOGARTY, CAITLIN ANNE	

ART UNIT	PAPER NUMBER
4116	

NOTIFICATION DATE	DELIVERY MODE
11/02/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,019	<b>Applicant(s)</b> SUDA ET AL.	
	<b>Examiner</b> Caitlin Fogarty	<b>Art Unit</b> 4116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>23 September 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Application***

1. Claims 1 – 4 are pending and presented for the examination.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) was submitted on September 23, 2005. This submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Please refer to applicant's copy of form PTO-1449 submitted herewith.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagao et al. (JP 2002-212665).

In regards to claim 1, the abstract and claims 1 – 3 and 6 of Nagao et al. disclose a spring steel with a clearly overlapping composition as shown in the table below.

Element	Claim 1 (mass %)	Nagao et al. (mass %)	Overlapping Range (mass%)
C	0.5 – 0.8	0.37 – 0.8	0.5 – 0.8
Si	1.2 – 2.5	≤ 3.0	1.2 – 2.5
Mn	0.2 – 1.5	0.2 – 2.0	0.2 – 1.5
Cr	1.0 – 4.0	≤ 3.0	1.0 – 3.0
V	0 – 0.5	≤ 0.01	0 – 0.01
P	0 < P ≤ 0.02	≤ 0.01	0 < P ≤ 0.01
S	0 < S ≤ 0.02	≤ 0.03	0 < S ≤ 0.02
Al	0 < Al ≤ 0.05	≤ 0.1	0 < Al ≤ 0.05
Fe + impurities	Balance	Balance	Balance

Nagao et al. does not specify that the spring steel is excellent in sag resistance and fatigue property, however since it has an overlapping composition that property would be inherent. See MPEP 2112.01. Also, Nagao et al. does not disclose the formula (1), however since the compositions of Si and Cr overlap with those recited in claim 1, the composition of Nagao et al. would satisfy formula (1).

Claim 2 is identical to claim 1 except the composition of Mn in claim 2 is ≥0.5 mass% which has an overlapping range of 0.5 – 2.0 mass% with Nagao et al.

Claim 3 is identical to claim 1 except the composition of Cr in claim 3 is ≥1.3 mass % which has an overlapping range of 1.3 – 3.0 mass% with Nagao et al.

Claim 4 is identical to claim one with the further addition of at least one selected from Ni: 0.5 mass% or less (excluding 0%) and Mo: 0.4 mass% or less (excluding 0%). Nagao et al. teaches a composition overlapping with claim 1 with the addition of  $\leq 2.0$  mass% Ni and/or  $\leq 1.0$  mass% Mo. Therefore, Ni has an overlapping range of  $0 < \text{Ni} \leq 0.5$  mass% and Mo has an overlapping range of  $0 < \text{Mo} \leq 0.4$  mass% with Nagao et al.

Since the claimed compositional ranges for claims 1 – 4 either overlap or are within the ranges disclosed by Nagao et al., a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the spring steel composition from the spring steel composition disclosed by Nagao et al. because both steels are used to make springs.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/549,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition of the spring steel recited in Application No. 10/549,753 overlaps in scope with the composition of the spring steel recited in claims 1 – 4 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

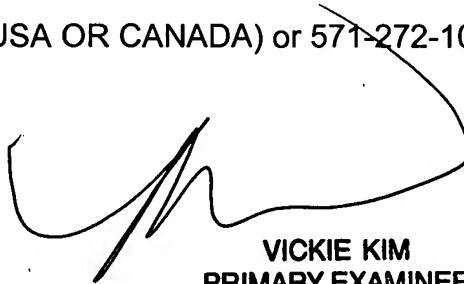
**Conclusion**

9. No claim is allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caitlin Fogarty whose telephone number is 571-270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CF



VICKIE KIM  
PRIMARY EXAMINER

SPE  
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